The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MAX A. FEDOR,
ERIC R. COLBURN, ROBERT G. GILLIO,
DANIEL W. NEU, and R. MICHAEL MCGRADY

Appeal No. 2003-1769
Application No. 09/014,076

ON BRIEF

Before MCQUADE, FRANKFORT, and ABRAMS, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

REMAND TO THE EXAMINER

Max A. Fedor et al. has appealed from the final rejection (Paper No. 10) of claims 38 through 53, all of the claims pending in the application. Before considering the appeal on its merits, we find it necessary to remand the application to the examiner for action consistent with the following remarks.

I. The final rejection includes a 35 U.S.C. § 102(e) rejection of claims 48 through 53 as being anticipated by U.S. Patent No. 4,847,764 to Halvorson and a 35 U.S.C. § 103(a)

rejection of claims 48 through 53 as being unpatentable over U.S. Patent No. 5,292,029 to Pearson. In the main brief (Paper No. 12), the appellants list these rejections as issues for review and argue the merits of same. In the answer (Paper No. 17), despite acknowledging that the appellants' statement of issues is correct, the examiner fails to restate the two rejections. In the reply brief (Paper No. 18), the appellants "acknowledge" that the two rejections have been vacated even though the examiner does not appear to have made any decision to this effect. In light of the foregoing, the status of the noted rejections is unclear. On remand, the examiner is directed to take appropriate steps to clarify this matter.

II. The final rejection includes, and the answer restates, a 35 U.S.C. § 103(a) rejection of claims 39 through 43, 45 through 47 and 49 through 53 as being unpatentable over U.S. Patent No. 5,562,232 to Pearson (Pearson '232) in view of U.S. Patent No. 5,883,806 to Meador et al. (Meador). In explaining the rejection, the examiner concedes that Pearson '232 does not disclose receiving data read from an object. This feature, however, which the examiner relies on Meador to supply, is recited only in claim 42. The examiner has not explained how Pearson '232 differs from the subject matter recited in the other

claims so rejected or how and why Meador is applied in combination with Pearson '232 to reject these other claims. On remand, the examiner is directed to take appropriate steps to clarify this matter.

III. The final rejection includes, and the answer restates, a 35 U.S.C. § 103(a) rejection of claims 38 through 53 as being unpatentable over Pearson '232 in view of U.S. Patent No. 5,377,864 to Blechl et al. (Blechl). In explaining the rejection, the examiner concedes that Pearson '232 does not disclose (1) displaying and entering data via a touch screen and (2) receiving data read from an object. These features, however, which the examiner relies on Blechl to supply, are recited only in claims 44 and 42, respectively. The examiner has not explained how Pearson '232 differs from the subject matter recited in the other claims so rejected or how and why Blechl is applied in combination with Pearson '232 to reject these other claims. On remand, the examiner is directed to take appropriate steps to clarify this matter.

IV. The record contains a 37 CFR § 1.131 Declaration by R. Michael McGrady, "a joint inventor of the subject matter described in claims 38-53" (declaration, ¶ 2). The appellants filed the declaration on August 30, 2000 (Paper No. 7) to swear

back of the Pearson '232 and Meador references. In this regard, the declaration seeks to establish that the invention claimed in the instant application, or an obvious variation thereof, "was completed by being conceived and reduced to practice in this country prior to March 7, 1994" (declaration, ¶ 6). The examiner appears to have found the declaration sufficient to show such conception and reduction to practice (see, for example, page 10 in the final rejection and page 16 in the answer). A cursory review of the declaration, however, shows (1) that it was made by only one of the joint inventors of the subject matter claimed,[1] and (2) that it is not accompanied by (a) any evidence documenting the asserted activities (see ¶ 5 in the declaration) leading to the alleged reduction to practice[2] or (b) a satisfactory explanation for the absence of such evidence.

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[1] This is especially troubling in light of (1) McGrady's many references in the declaration to "my" invention and activities which "I" performed and (2) the lack of any specific mention in the declaration of the contributions to the claimed invention of the other joint inventors.

[2] The only evidence submitted with the declaration is a SelecTrac Functional Specification (Software) document attached as Exhibit A. This exhibit is proffered in conjunction with the declarant's assertion of a conception of the claimed invention (see ¶ 5a of the declaration), and does not, and is not asserted to, constitute proof of the stated activities.

Hence, the declaration appears on its face to be fatally flawed for the reasons specified in MPEP §§ 715.04 and 715.07. On remand, the examiner is directed to reassess the merits of the declaration and to take appropriate action consistent with the reassessment. If the declaration is again found to be acceptable, the examiner is further directed to cogently explain why the above criticisms are unfounded.

The application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01 (Eighth Edition, Aug. 2001), item (D). It is important that the Board of Patent Appeals and Interferences be promptly informed of any action affecting the appeal in this case.

REMANDED

NEAL E. ABRAMS)
Administrative Patent Judge)
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) BOARD OF PATENT
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CHARLES E. FRANKFORT) APPEALS AND
Administrative Patent Judge)
) INTERFERENCES
)
JOHN P. MCQUADE)
Administrative Patent Judge)

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